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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Sperry et al. Group Art Unit: 1772
Serial No.: 10/057,067 Examiner: Simone, Catherine
Filing Date: January 25, 2002 Docket No.: D-30259-01
Title: APPARATUS AND METHOD FOR FORMING INFLATED CHAMBERS

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REPLY BRIEF UNDER 37 CFR § 41.41

Sir:

This Reply Brief is being filed in response to the Examiner's
Answer mailed March 23, 2006.

At part 10 of the Examiner's Answer, i.e., the "Response to
Argument" section, the Examiner contends that

Jostler and De Luca each teach a packaging
material and therefore are recognized as art
equivalents. (Examiner's Answer, page 6.)

On this basis alone, i.e., “[d]ue to the fact that De Luca and Jostler each teach a packaging material,” the Examiner concludes that

one skilled in the art would clearly be able to modify the longitudinal flanges of the inflatable web in De Luca to have a pair of open, unsealed edges as suggested by Jostler in order to provide an alternative way to inflate the chambers, if so desired. (Examiner’s Answer, page 7.)

The same argumentation is used several more times throughout the remainder of the “Response to Argument” section of the Examiner’s Answer (see, Pages 8-9).

In response, Appellants point out that the foregoing line of argumentation does not constitute a legally-sufficient basis to support a *prima facie* showing of obviousness.

In the first place, a determination that two references pertain to the same field of endeavor, e.g., “packaging,” is, at best, only a preliminary consideration in an obviousness analysis. See, e.g., MPEP §2141.01(a). The legal criteria that must be met in order to conclude that the teachings of the references may be combined in such a way as to arrive at a claimed invention are summarized in MPEP §§2142-43. As set forth and discussed at length in Appellants’ Appeal Brief, there must be (1) some suggestion or motivation in the prior art to combine the teachings of the references, and (2) a reasonable expectation of success.

The Examiner’s observation that “De Luca and Jostler each teach a packaging material” does not satisfy the foregoing requirements. This is particularly true in view of Appellants’ extensive remarks in their Brief, which demonstrate that neither requirement is met by the combination of De Luca and Jostler.

Moreover, nothing is of record to establish that the De Luca and Jostler references are “art equivalents.” The field of packaging is quite

vast, with a countless variety of different ways to package goods. Jostler is directed to a particular type of packaging application, in which material to be packaged is poured into a pocket, such that the pocket itself becomes the package. In contrast, De Luca is directed to inflatable cushioning, in which an inflatable web is inflated and then placed inside of a package, along with the packaged goods, in order to protect the goods by absorbing transmitted shock during shipment. The two types of packaging material described in Jostler and De Luca are quite different; they have almost nothing in common. For example, the longitudinal slots or perforations 29, 79 that extend into the pockets 26 of Jostler to facilitate the filling thereof would make it difficult, if not impossible, to inflate such pockets. Thus, far from being “art equivalents,” Jostler and De Luca can hardly even be said to be in the same field of endeavor.

In the second of the above-quoted passages from the Examiner’s Answer, the Examiner suggests that one skilled in the art would “be able to modify” the longitudinal flanges of the inflatable web in De Luca to have a pair of open, unsealed edges as suggested by Jostler “in order to provide an alternative way to inflate the chambers (emphasis added).”

As noted in Appellants’ Brief, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (emphasis in original).” *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992). While the Examiner goes on to state that “the prior art as a whole suggested the desirability of the combination of the inflatable web limitations claimed (Examiner’s Answer, page 7),” no teaching in either De Luca or Jostler is referenced in the Examiner’s Answer to substantiate this assertion.

Indeed, far from suggesting the desirability of the combination, the proposed modification of De Luca would render the De Luca web unsatisfactory for its intended purpose because the outlet ports 37 would no longer be present “to regulate the level of the air pressure within the inflation channel 31” (col. 6, lines 51-55), or to allow escaping air from the outlet ports to be sensed by a pressure transducer (paragraph bridging cols. 5-6). Moreover, converting the enclosed inflation channel of De Luca to a pair of unsealed flanges would completely change the principle of operation of the De Luca invention because the resultant open flange-edge would no longer be capable of maintaining itself in an inflated state to direct pressurized air into the inflatable strips (col. 6, lines 45-50).

Accordingly, there is no basis in the cited references to support the Examiner’s theory that the prior art suggested the desirability of the proposed combination of De Luca and Jostler. To the contrary, when the two references are read as whole, their respective teachings would have dis-incentivized one of ordinary skill in the art to make the proposed combination for the reasons stated above, which are discussed more fully in Appellants’ Brief.

Finally, in response to the Examiner’s suggestion that one of skill in the art would have been motivated to modify De Luca based on Jostler “in order to provide an alternative way to inflate the chambers (Examiner’s Answer, page 7 (emphasis added); see, also, page 9),” Appellants respectfully submit that this is nothing more than hindsight-based speculation, which has no support in the teachings of the references of record.

The only method of inflation taught in De Luca requires an inflatable web having an enclosed inflation channel. Specifically, De

Luca inflates each of the inflatable strips 21 indirectly by first inflating the inflation channel 31 with pressurized air (via inflation tube 59, which is positioned within the channel); the inflated channel then directs the pressurized air into the entrance ports 41 of each of the inflatable strips (col. 6, lines 5-10). This is the sole mode of operability taught by De Luca – no alternative ways of inflating the inflatable strips are suggested or even hinted at.

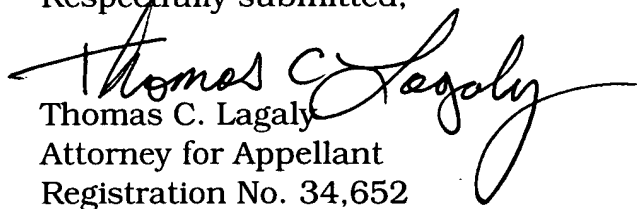
Jostler does not teach or suggest an inflatable web, and thus similarly provides no information to the skilled artisan regarding an alternative way of inflating an inflatable web.

If De Luca's inflation channel were modified by changing the enclosed inflation channel into a pair of flanges having open, unsealed edges as proposed, the resultant flange-edge would no longer be capable of maintaining itself in an inflated state to direct pressurized air into the inflatable strips 21, thereby radically changing De Luca's principle of operation. As was the case in *In re Ratti*, the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [De Luca] as well as a change in the basic principle under which the [De Luca] construction was designed to operate." 123 USPQ 349, 352 (CCPA 1959). As such, the rejection cannot stand.

Accordingly, Appellants respectfully urge that when the De Luca and Jostler references are read as a whole and without resort to hindsight reconstruction based on Appellants' disclosure, it is clear that the proposed combination of those references lacks both a motivational basis and an expectation of success. Such combination, therefore, does not constitute a *prima facie* case of obviousness against the claims on appeal.

For the reasons stated above as well as those set forth in the Appeal Brief filed January 19, 2006, Appellants respectfully request that the rejections be reversed and that all of the claims on appeal be allowed.

Respectfully submitted,


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